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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,751	05/25/2000	Theodore Jack London Shrader	AUS000168US1	6562

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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/578,751

Applicant(s)

SHRADER ET AL.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. In view of the appeal brief (hereinafter "First Appeal Brief") filed on June 10, 2004 (Paper No. 18), PROSECUTION IS HEREBY REOPENED. An Office Action on the merits is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 C.F.R. §1.113; or,
- (2) request reinstatement of the appeal.

2. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR §1.130, §1.131 or §1.132) or other evidence are permitted. See 37 C.F.R. §1.193(b)(2).

Acknowledgements

3. In view of Applicant's First Appeal Brief, the after final amendment filed June 10, 2004 has been entered. Accordingly, claims 1-14 remain pending. In accordance with Applicants' instructions, claim 15 has been cancelled.

4. In light of this amendment and because this application now only contains claims directed to Invention I as defined in the restriction mailed April 22, 2003 (Paper No. 7), the restriction is improper. Accordingly, the Examiner hereby withdraws the restriction requirement as noted in Paper No. 7.

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5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.

Claim Rejections - 35 USC §101

6. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-9 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test:

- (1) The invention must be within the technological arts; and
- (2) The invention must produce a useful, concrete, and tangible result.

8. The claims do not produce a “useful, concrete, tangible result.” *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1453 (Fed. Cir. 1999); *In re Warmerdam*, 33 F3d 1354, 31 USPQ2d 1754 (Fed Cir 1994). The Examiner suggests, by way of example only, Applicants actually recite in claim 1 --generating a data record-- or some other useful, concrete, and tangible step instead of “to generate a data record”

Claim Rejections - 35 USC §112 2nd Paragraph

9. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claims 1-14 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 1-9 are indefinite because the scope of the claims can not be determined since they are directed towards non statutory subject matter. If Applicants overcome the §101 rejections above, this particular 35 U.S.C. §112, 2nd paragraph rejection will be withdrawn.

12. Claim 4 is indefinite because the metes and bounds of the claim can not be determined. In particular, it is unclear if the phrase “the given action is selected from the actions consisting essentially of” in claim 4 is ‘in addition to,’ or ‘in replacement of,’ the phrase “taking a given action” as recited in claim 3.

13. In claim 8, it is unclear what is a “fuzzy match”

14. Claim 6-9 is indefinite because the metes and bounds of the claim can not be determined. In particular, it is unclear if the phrase “wherein the profile includes matching criteria that must be met for the item name” in claim 6 is ‘in addition to,’ or ‘in replacement of,’ the phrase “generating a profile” as recited in claim 1. Additionally, it is unclear if the “exact match” in claim 7 and the “fuzzy match” in claim 8 are ‘in addition to,’ or ‘in replacement of,’ the “matching criteria” in claim 6.

15. In claim 10, it is unclear if the term “each” in line 3 refers to the “set” or to the “profile” itself.

16. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are

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indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC §102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

18. Claims 1-14, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Streetprices.com (website printout of January 25, 1999) (“Streetprices 1/99”). Streetprices 1/99 discloses generating a set of product profiles (see *e.g.* “Computers”, “Flowers” and “Toys”), each identifying a given site URL (inherent); a list of one or more included items to be queried (the product to be searched), a scan interval (inherent in the graphs) and a site template (inherent in HTML and XML; periodically retrieving data from the given site URL (inherent in the x axis of the graph) according to the scan interval; parsing the data retrieved to generate a data record (inherent since it discloses the price over time); storing the

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data records (inherent); and the product profiles includes one or more triggers (a threshold price which sends an email when a price drops below a particular level).

19. Claims 1-14 are alternatively rejected under 35 U.S.C. §102(b) based upon a public use or sale of the invention. In this case, evidence to support the public use is the StreetPrices.com website. See the additional cited StreetPrices.com printouts noted in the previous office actions (Paper No. 9, Paragraph No. 20).

20. Claims 1-14, as understood by the Examiner, are also rejected under 35 U.S.C. §102(e) as being anticipated by Bailey et. al. (U.S. 6,785,671) ("Bailey"). Bailey discloses generating a profile (a product score) identifying a given site URL; an item to be queried, and a scan interval (frequency with which the product spider is refreshed); retrieving data from the URL; parsing the data (extracting the data); storing the data record (inherent); comparing the associated price to a given threshold condition (threshold be the score); taking an action (including the website in the database) if the condition occurs; logging an event (inherent in the recording of events).

Claim Rejections - 35 USC §103

21. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 1-14, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Streetprices 1/99 in view of Chung et. al. (U.S. 6,738,767

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B1)(“Chung”).¹ It is the Examiner’s principle position that the claims are anticipated because Streetprices 1/99 inherently discloses a site template. Site templates are inherent in their HTML and XML documents.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Bailey as taught by Chung to include a site template. Such a modification would have merely disclosed that which is already well known in the art. Such a modification would have helped allow the conversion of different HTML documents, written in different styles, into XML documents following a common schema.

23. It is the Examiner’s position that the non-functional descriptive material (see *e.g.* the “associated price data” as recited in claim 5) is not functionally involved in the steps of the claims.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the content of Streetprices 1/99 with any type of content. The descriptive material will not distinguish the claimed invention over the prior art in terms of patentability because the data does not functionally relate to the steps in the method. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). See also MPEP §2106 IV B.

24. It is the Examiner factual determination that using a parsing mechanism to extract data from HTML and XML documents is old and well known in the art. See *e.g.* Lin (U.S. 6,381,597 B1), Ferret (U.S. 6,430,553 B1), and Christianson et. al. (U.S. 6,102,969)(“Christianson”).

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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25. Claims 1-14, as understood by the Examiner, are also alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Bailey in view of Chung. It is the Examiner's principle position that the claims are anticipated because Bailey inherently discloses a site template. Site templates are inherent in their HTML and XML documents.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Bailey as taught by Chung to include a site template. Such a modification would have merely disclosed that which is already well known in the art. Such a modification would have helped allow the conversion of different HTML documents, written in different styles, into XML documents following a common schema.

26. For due process purposes, the Examiner again confirms that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner again notes the following factual findings as first discussed in the previous Office Actions.² First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements³ with

² See the First Non Final Office Action mailed July 29, 2003, Paper No. 9, Paragraph No. 17; the First Final Office Action mailed November 6, 2003, Paper No. 11, Paragraph No. 12.

³ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

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the required clarity, deliberateness, and precision.⁴ Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked,⁵ Applicants' responses have not point out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants did not argue lexicography *was* invoked). Forth and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation to be their own lexicographer. Finally, after receiving express notice of the preceding factual findings and conclusions, Applicants' latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b). Moreover, Applicants' latest response—while fully considered by the Examiner—does not change the Examiner's conclusion that Applicants have decided not to be their own lexicographer. Therefore, the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.⁶

27. The Examiner continues to rely on the definitions as noted in the previous First Final Office Action.

⁴ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁵ See Note 2.

⁶ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

Response to Arguments

28. Applicants' arguments filed in their appeal brief have been fully considered but they are not persuasive.

Lexicography

29. Applicants' First Appeal Brief expressly states that "Appellants acknowledge that definitions found in the present specification for specific terms in the claims are not being relied upon at this time."⁷

30. First, it is important to remember the Examiner has never *required* Applicants to be their own lexicographer. It is Applicants' burden to define their invention, not the Examiner's.⁸ In complying this burden, Applicants are reminded that it is Applicants—and *not* the Examiner—who drafted the claims, specification, and drawings and it is therefore *Applicants* who must decide whether or not to be their own lexicographer.⁹ Along the same line of reasoning, whether or not Applicants choose this or that particular method of claim construction (*e.g.* lexicography or perhaps 35 U.S.C. §112 6th paragraph) is also completely within Applicants' discretion.

31. Second, Applicants are reminded that claim terminology is fixed upon filing. See *Middleton Inc. v. Minnesota Mining and Manufacturing Co.*, 311 F.3d 1384, 1389, 65 USPQ2d 1138, 1142 (Fed. Cir. 2002) ("The meaning of a patent term, however, is not subject to revision .

⁷ Applicants' First Appeal Brief, Page 6.

⁸ *In re Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029 (quoting 35 U.S.C. §112 2nd paragraph, "It is the applicants' burden to precisely define the invention, not the PTO's.").

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... The meaning of patent terms depends on the usage of those terms in context by one of skill in the art *at the time of application*. [Emphasis added.]”); *Wiener v. NEC Elecs., Inc.*, 102 F.3d 534, 539, 41 USPQ2d 1023, 1027 (Fed. Cir. 1996) (“Ultimately, a court must construe the claim language according to the standard of what those words would have meant to one skilled in the art *as of the application date*. [Emphasis added.]”)(overruled on other grounds in *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454-55, 46 USPQ2d 1169, 1173 (Fed. Cir. 1998) (en banc)); *Plant Genetic Systems N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1345, 65 USPQ2d 1452, 1460 (Fed. Cir. 2003)(“We hold that the district court did not ignore the plain meaning of the claims, but properly gave objective meaning to them as they were understood *at the time the patent application was filed*. [Emphasis added.]”); and *Kopykake Enterprises Inc. v. Lucks Co.*, 264 F.3d 1377, 1383, 60 USPQ2d 1124, 1127 (Fed. Cir. 2001) (“[W]hen a claim term understood to have a narrow meaning when the application is filed later acquires a broader definition, the literal scope of the term is limited to what it was understood to mean at the time of filing.”). So once an applicant files his or her specification, the meaning of *all* claim terms—both lexicographic and non-lexicographic—are fixed. While the meaning may not be ‘uncovered’ or ascertained until inter partes litigation,¹⁰ the meaning of all claim terms nevertheless remains fixed. Obviously, failure to construe a claim during either ex parte examination or inter partes

⁹ See e.g. *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 USPQ 1025, 1031 (Fed. Cir. 1984) (noting that “It is the inventor applying for a patent who is permitted to be his own lexicographer,” not the examiner).

¹⁰ See e.g. *Jack Gluttman, Inc. v. Kopykake Enterprises, Inc.*, 302 F.3d 1352, 1360, 64 USPQ2d 1302, 1307 (Fed. Cir. 2002) (“Where, as here, the patentee has clearly defined a claim term, that definition usually is dispositive; it is the single best guide to the meaning of a disputed term.”).

litigation does not change the fact that the meaning of claim terms is fixed upon filing. And terms or definitions that actually *change* claim meaning by their inclusion *after* filing the filing date of the application are improper under either 35 U.S.C. §112 1st paragraph and/or 35 U.S.C. §132 since it is axiomatic that any *change* from an initial meaning would clearly constitute new matter.

32. Third, the Examiner recognizes that drafting patent applications is a complicated process requiring the drafter to consider many complex issues.¹¹ However this does not relieve the drafter of deciding whether or not to be their own lexicographer and if affirmative, unequivocally stating those definitions in the specification. Such definitions and associated issues must be contemplated *prior to* filing the patent application. See *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 21 USPQ2d 1383 (Fed. Cir. 1992) noting that for lexicography and quoting *Lear*, “the place to do so is in the specification of the inventor’s application, and the time to do so is *prior to* that application acquiring its own independent life as a technical disclosure through its issuance as a United States patent. [Emphasis added.]” *Intellicall*, 952 F.2d at 1388, 21 USPQ2d at 1386.

33. Having established that claim terms are fixed upon filing and that Applicants are the masters of their domain, the Examiner has simply required that if Applicants *know of* or *intended* to be their own lexicographer, the Examiner respectfully requested that they point it out now. After the Examiner has brought this issue to Applicants’ attention and after the Examiner has shown reliance on the *lack* of lexicographic definition(s) to interpret the claims, Applicants’

¹¹ See e.g. *Johnson & Johnston Associates*, 285 F.3d at 1069, 62 USPQ2d at 1241, Newman, J., dissenting (“Patentees often must draw lines in order to claim their invention with specificity.”).

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continued failure to point out any *known* lexicographic definition(s) would be a violation of 37 C.F.R. §1.111(b),¹² and perhaps, Applicants' duty of candor and good faith under 37 C.F.R. §1.56 which states in part: "(a) ... Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office"

34. Applicants' statement that "definitions found in the present specification for specific terms in the claims are not being relied upon at this time" is considered non-responsive. As noted in *In re Bass*, 314 F.3d 575, 577-78, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002), "Bass chose to define 'motorized sports boat' in the specification. He cannot change or modify that definition on appeal." So if Applicants in this case are aware of *any* lexicographic definition in the specification that is currently used in the claims, they cannot change or modify that definition. In other words, if a lexicographic definition is found in the specification and that term is currently used in the claims, that lexicographic definition must be used—it is not optional. And if Applicants intend to be their own lexicographer, that definition must be provided with the required clarity, deliberateness, and precision.

35. In any event, one point however is clear, such comments by Applicants unmistakably confirm that Applicants have received notice of the Examiner's factual findings and legal

¹² For additional guidance on how the USPTO interprets 37 C.F.R. §1.111(b) see *e.g.*: MPEP §818.03(a) quoting §1.111(b) and noting that applicant is required to point out the supposed errors in the next response by stating *why* the Examiner's position regarding restriction is *substantively* incorrect in order to preserve his or her right to petition; MPEP §2144.03 regarding Official Notice noting that traversal must be made in applicant's *next response*. "A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well know statement *in the next reply* after the Office action in which the well known statement is made. [Emphasis added.]" Failure to seasonable challenge the official noticed statement *in the very next response* means the statement is interpreted as admitted prior art; and *In re Goodman*, 3 USPQ2d 1866, 1871 (ComrPats 1987)

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conclusions regarding lexicography invocation and have been given the opportunity to defend against the noticed liabilities.

Other Issues

36. In response to Applicants' arguments, the recitation "a client computer" has been considered but has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

37. Applicants' response to the Examiner's position on inherency is acknowledged. Applicants' arguments are not persuasive.

Conclusion

38. Applicants' amendment (Amendment 'B' filed October 29, 2004, Paper No. 10) necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicants are also reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

noting the examiners have no authority to waive 37 C.F.R. §1.111(b) and that an applicant is

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

39. References considered pertinent to Applicants' disclosure are listed on form PTO-892.

40. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

41. Because this application is now final, Applicants are again reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been*

required to point out *any* supposed errors in his next response.

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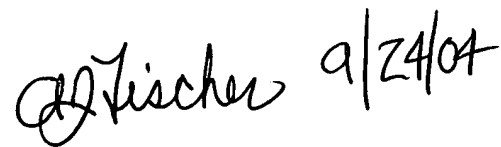
addressed with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

42. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

43. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their arguments in their First Appeal Brief traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹³ the Examiner respectfully reminds Applicants to properly traverse the Examiner's position(s) in

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accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
September 24, 2004

¹³ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.